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| 09/641,095 | 08/17/2000 | Donald B. Benson | 40016420-0001 | 5295 |
| 26565 | 7590 | 03/13/2006 | EXAMINER | |
| MAYER, BROWN, ROWE & MAW LLP P.O. BOX 2828 CHICAGO, IL 60690-2828 | | | ROBINSON BOYCE, AKIBA K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3639 | |

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/641,095 | BENSON, DONALD B. | |
| | Examiner Akiba K. Robinson-Boyce | Art Unit 3639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 December 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 9,13-15,18,21-23 and 28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 21-23 is/are allowed.

6) Claim(s) 9,13-15,18, and 28 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Status of Claims

1. Due to communications filed 12/8/05, the following is a final office action. Claims 9, 13-15, 18, 21-23 and 28 are pending in this application and have been examined on the merits. Claims 21-23 are allowed, however, claims 9, 13-15, 18, 21-23 and 28 are rejected as follows. The previous action has been maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al (US 5,287,976).

As per claim 9, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1 ; col. 6, lines 21-61);

a print head (18) printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first

portion of each of the plurality of diverse publications (see Fig. 1), and a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28' in Fig. 5), and

a sortation device (60).

However, Mayer et al. does not expressly disclose the second print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. B. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the

ad at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

The modified Mayer et al. discloses the invention as recited above, but does not further expressly disclose the system having the first and second print heads at the co-mailer instead at the bindery.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to move the print head from the present location (bindery) to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified system of Mayer because the Mayer reference discloses the system for co-mailing, comprising: a bindery for binding a plurality of signatures and a print head for printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and a co-mailer including: a merge stream and a sortation device.

Therefore, it would have been an obvious matter of design choice to modify Mayer to obtain the invention as specified in claims for the purpose of printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of the

diverse publications.

As per claim 18, Mayer et al. discloses a system comprising:

a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (see 28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28' in fig. 5);

a sortation device (60); and

a co-mailer control module (32, 32') controlling a first print head (18).

However, Mayer et al. does not expressly disclose an additional print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of pads has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print

heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior ad because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

The modified Mayer et al. discloses the invention as recited above, but does not further expressly disclose the system having the first and second print heads at the co-mailer instead at the bindery.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to move the print head from the present location (bindery) to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform

equally well with the modified system of Mayer because the Mayer reference discloses the system for co-mailing, comprising: a bindery for binding a plurality of signatures and a print head for printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and a co-mailer including: a merge stream and a sortation device.

Therefore, it would have been an obvious matter of design choice to modify Mayer to obtain the invention as specified in claims) for the purpose of printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of the diverse publications.

As per Claim 28, Mayer et al. discloses a system comprising:
a plurality of pockets for receiving the plurality of publications (see Fig. 5);
a merge stream for merging the plurality publications; and
a print head (18) printing an identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications (see Fig. 1).

However, Mayer et al. does not expressly disclose the second print head.

When the invention was simply directed to the duplication of parts for a multiplied effect, the court held that mere duplication of pads has no patentable significance

unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) and *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977).

Here, the applicant's invention is directed to the co-mailer including two print heads (duplication of the print head). Although having two print heads would have a multiplied effect of printing the information on the publications faster than the system having just one print head, it would have no patentable significance or patentably distinguish over the prior art because Mayer et al. can print the same information on the publication although the printing process may be slower than the one having two print heads. The print head of Mayer et al. can print the information on the multiple areas in a customized orientation and placement of the publications.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time of the invention to add the additional print head to the system of Mayer et al. for the purpose of printing the identifier information on the publication faster and more efficiently.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. (US 5,287,976), and in view of Delfer III, (US 5,264,665).

As per claim 13, Mayer et al. discloses a system comprising:
a bindery for binding a plurality of signatures, the bindery binding the plurality of signatures to create a plurality of first publications and a plurality of second publications, each of the plurality of first publications and each of the plurality of second publications being an order, the order identifying each of the plurality of first and second publications

with each of the plurality of recipients (see Fig. 1 ; col. 6, lines 21-61); and
a co-mailer (28' in Fig. 5) comprising:
a merge stream for merging the plurality of first publications and the second
publications in the order to mail the diverse publications to the plurality of recipients (see
28' in Fig. 5); and
a sortation device (60).

However, Mayer et al. does not expressly show the system including a thickness
measurement device and scale.

Delfer III teaches utilizing the thickness measurement device and scale (30 in
Fig. 1A) for optimizing the mailing discount rates.

It would have been obvious to a person having ordinary skill in the art at the time
of invention to employ the scale and thickness gage by the system, as taught by Delfer,
111, for the purpose of optimizing the postal discount for the mailing.

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Mayer et al. in view of Humes et al. (US 5,377,120).

As per claims 14-15, Mayer et al . discloses a system comprising:
a bindery for binding a plurality of signatures, the bindery binding the plurality of
signatures to create a plurality of first publications and a plurality of second publications,
each of the plurality of first publications and each of the plurality of second publications

being an order, the order identifying each of the plurality of first and second publications with each of the plurality of recipients (see Fig. 1; col. 6, lines 21-61); and

a co-mailer (28' in Fig. 5) comprising:

a merge stream for merging the plurality of first publications and the second publications in the order to mail the diverse publications to the plurality of recipients (see 28'), and

a sortation device (60).

However, Mayer et al. does not expressly show the system including a co-mailer merge and sequence module for receiving a plurality of verified sequence list from the bindery, each of the plurality of verified sequence lists containing the order for each of the plurality of publications received from the bindery, the co-mailer merge and sequence module merging each of the plurality of verified sequence lists to create a merged verified sequence list, the merged verified sequence list sequenced in the order to determine the mail rate.

Humes et al. teaches an apparatus for co-mailing mail pieces by taking the various mailing lists, merging and sorting the entries into lowest postal rate groupings and utilizing this merged data base to enable a sequence controller and associated device to physically co-mail and address the mail pieces (see Figs. 1-3 and the descriptions thereof; abstract; and col. 2, lines 38-68).

It would have been obvious to a person having ordinary skill in the art at the time

of invention to incorporate the co-mailer merge and sequence module of Humes et al. into the co-mailing system of Mayer et al., for the purpose of preparing a plurality of preprinted un-addressed, non-alike mail pieces from un-predetermined sources into grouped bundles organized in a manner to receive low postal rates.

Allowable Subject Matter

6. Claims 21-23 are allowed.

Response to Arguments

7. Applicant's arguments filed 12/8/05 have been fully considered but they are not persuasive.

The applicant traverses the Examiner's determination the "it would have been obvious to one having ordinary skill in the art to move the print head from the present invention location to the co-mailer because Applicant has not disclosed that installing the print head at the co-mailer erat6her than at the bindery provides an advantage, is used for a particular purpose or solves a stated problem". The applicant argues that the Mayer Reference discloses a printer at the bindery only, not the co-mailer.

However, as disclosed in the previous rejection, the Applicant has not disclosed that installing the print head at the co-mailer rather than at the bindery provides an advantage, is used for a particular purpose, or solves a stated problem, and the applicant's argument is therefore moot. Furthermore, one of ordinary skill in the art, would have expected Applicant's invention to perform equally well with the modified system of Mayer because the Mayer reference discloses the system for co-mailing, comprising: a bindery for binding a plurality of signatures and a print head for printing an

identifier information on each of the plurality of diverse publications in a customized orientation and a customized placement on a first portion of each of the plurality of diverse publications; and a co-mailer including: a merge stream and : sortation device. In addition, it would have been obvious to one having ordinary skill in the art to move the print head from the present location to the co-mailer because in Mayer, after binding, the publications may be rolled up on bundles, that are then identified, and stored for later co-mailing at the co-mailer. Since the publications are stored at the co-mailer, it is obvious to print at the co-mailer since printing involves physically producing a physical copy of stored data.

In addition, the applicant argues that prior art teaches away from allowing each publication to have the mail rate printed on it by the print heads at the co-mailer since the reference teaches having the copies in stacks, not individually. As stated in the previous action, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the Mayer reference does disclose that the sortation device sorts the diverse publications. Although the applicant has submitted an argument indicating the structural difference between the claimed sortation device and that of the Mayer reference as allowing the

publication to have the mail rate printed on it, the Mayer sortation device is still capable of performing the intended use as claimed by the applicant. In addition, Mayer also discloses that an ink jet printer for addressing each of the diverse publications at a point before the copies exit from the binding line in col. 4, lines 59-61. This represents the ability for the Mayers reference to allow each publication to have the mail rate printed on it by the print heads.

As per claim 13, the applicant argues that since the examiner states that the Mayer reference shows all of the elements of the claim except for the "thickness measurement device and scale", that the examiner is not making a *prima facie* case of obviousness, and does not meet three criteria as explained in M.P.E.P 2143. However, the rejection does meet the criteria of the MPEP since claim 13 is rejected as being obvious over Mayer, in view of the Delfer reference. This rejection not only discloses the Meyer reference, but discloses the combination of Mayer and Delfer, and therefore does meet the criteria of the MPEP. Although this rejection does state that Mayer does not teach the "thickness measurement device and scale", it also discloses that Delfer III teaches utilizing the thickness measurement device and scale as shown in 30 of Fig. 1A for the purpose of optimizing the postal discount for the mailing. Also, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only

from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant also argues that there is no suggestion or motivation to combine the references. However, the Mayer and Delfer references are combinable. First, Mayer discloses a co-mailing system that further merges book titles for postal discount purposes, and Delfer discloses a computer directed system for discounted direct mailing that optimizes the postal discount for the mailing. Since both references are directed towards systems that encourage postal discounts for mailing purposes, the combination of the Mayer and Delfer references is valid.

As per claim 14, the applicant argues that there is no motivation of combining the Mayer reference with the Humes. However, the Mayer and Humes references are combinable. First, Mayer discloses a co-mailing system that further merges book titles for postal discount purposes, and Humes discloses lowering the mailing costs by producing bundles for low postal rate mailings. Since both references are directed towards systems that encourage postal discounts for mailing purposes, the combination of the Mayer and Humes references is valid.

As per claim 15, the applicant argues that the examiner has made no showing as to where the "co-mailer control module", different than the "co-mailer merge and sequence module" is shown in either the Mayer or Humes reference, and has not shown the motivation and suggestion to combine the two references. However, it is disclosed in the rejection that the Mayer et al. reference does not expressly show the system including a co-mailer merge and sequence modules as disclosed by the present

invention. However, the rejection does disclose that the combination of Mayer and Humus teaches these limitations. Specifically, it is shown that Humes et al. teaches an apparatus for co-mailing mail pieces by taking the various mailing lists, merging and sorting the entries into lowest postal rate groupings and utilizing this merged data base to enable a sequence controller and associated device to physically co-mail and address the mail pieces in Figs. 1-3 and the descriptions thereof; abstract; and col. 2, lines 38-68. It is these sections of Humes et al that discloses the co-mailer merge and sequence modules. In addition, the Mayer and Humes references are combinable as shown above in the preceding paragraph.

For the reasons stated above, the previous rejection has been maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

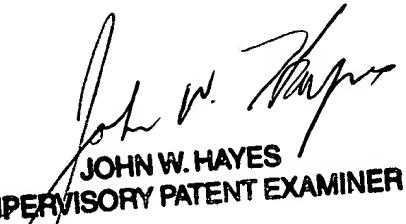
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.
February 22, 2006



JOHN W. HAYES
SUPERVISORY PATENT EXAMINER